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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,553	07/31/2000	Stacy Haituka	72189/98118B	4088

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EXAMINER

CHOUDHARY, ANITA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,553

Applicant(s)

HAITSUKA ET AL.

Examiner

Anita Choudhary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on April 16, 2004 has been entered. Claims 11, 13, and 15 have been amended and are presented for further examination.

Claims 1-29 are presented.

Response to Arguments

Applicant's arguments filed April 16, 2004 have been fully considered but they are not persuasive.

In referring to claim 1 and 22 applicant contends that the prior art reference belonging to Radziewicz et al (US 5,854,897), hereinafter referred to as, Radziewicz, do not show all limitation of the claimed features. Applicant argues:

1. The combination of Modified Browser Client Software (26) on a DTE (14) and the Modified Network Server Software (24) on the Network Provider (16) do not teach "a client application on a local device."

In response, in view of the entire claim, the "client application" has many operations, in brief including: the client application activating, the client application establishing a communication channel, the client application causing advertisements to be displayed on output device, and the client application monitoring the user's interactions. The particular limitation pointed out above and in context with the claim addresses, "A method of displaying advertisements to a user of an online service using a client application on a local device..."

Examiner interprets this limitation to mean that the client application for displaying

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advertisements is housed within the confines of the local device. Accordingly, Radziewicz shows the client application (browser client software) operable for displaying advertisements to a user being on a local device (14) (col. 5 lines 26-31).

There are other aspects or operations carried out by the client application which are not necessarily restricted to the confines of the local device. As pointed out in the Application Specification on page 25 lines 7-10, "Although at least some aspects of the client application 110 should be operable from the local device 100, the client application 110 need not be stored on the local device 100 and can be run from a remote location." Accordingly, all operations of a client application need not be at the local device.

2. Applicant argues that the "client application activating" is not taught by the Radziewicz.

In response, Radziewicz shows the client application (browser client software) activated by being executed on the DTE (see col. 5 line 37).

3. Applicant argues that Radziewicz does not show, "the client application monitoring the user's interaction with the local device with respect to the client application and thereby detecting whether the user is interacting with the online service."

In response, Examiner would like to point out the previous argument in reference to number 1 above. Further, the client application has separate operations and in this limitation the client application monitors the user's interactions with the local device. The intent of monitoring is to detect whether the user is interacting with the online service. Examiner interprets interaction with an online service to mean interaction with the online server. This is supported by line 3-4 of claim 1 wherein, "the user using local device for accessing online server

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associated with the online service and providing interactions with the online service". Therefore, it becomes difficult to separate the operation of monitoring a local device strictly to the confines of the local device without considering the communications link from the local device used for accessing an online server. In other words, a communication channel established by the client application is monitored to detect interactions. Furthermore, the "user's interaction with the local device with respect to the client application" simply restricts the monitored interaction to those originating at the local device. Examiner recognizes the Applicants specification on page 34 line 6 describes "user interaction" comprising "a user manipulating a computer input device, such as a keyboard or mouse, with respect to local device". The specification also shows that the user interaction is measured with respect to the user interacting with the online service using the client window (Specification, page 34 lines 10-12). And to interact with the online service requires communication over a communication link. In addition, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Application argues that "idle" is fundamentally different from "inactive".

The final claim limitation points to a user that has not interacted with the local device with respect to the client application which causes a dialog that displays notification that the user has been inactive with respect to the online service. Accordingly, Examiner fails to see the distinction between idle and inactive. Examiner interprets the inactivity of the claim being measured as the lack of interaction with the online service, which occurs over a communications link that was established by the client application. Both refer to the lack of activity on a communication line; therefore in this case idle and inactive are similar.

5. Applicant argues that the limitation stating: “the client application causing a dialog to be displayed on the output device of the local device,” has not been addressed by the rejection.

Attention is drawn to the client application (26) causing a dialog shown in fig. 8A-8D items 66, 76, 82, 84, wherein the dialog is displayed on the output device of the local device (14). These were pointed out in the previous rejection.

6. In referring to claim 3 and 24, Applicant contends that rejection did not address the feature “at least one display attribute for the given advertisement.” Or teach “the first play list further specifying an order in which the advertisements are to be displayed.”

In response, Radziewicz shows display attributes for given advertisements on a window displayed to the user monitor (fig. 8A). Furthermore, Radziewicz shows clock recording a play list of sequenced announcements transmitted to user’s display similar to the order of advertisements to be displayed of the claim (col. 9 lines 38-39).

7. In referring to claim 4 and 25, Radziewicz shows the play list of announcements being “paused” via the logout procedure which logs or records all the relevant information about the advertising messages that were transmitted to the DTE so that when the user logs back in, ads will begin where they left off (col. 15 lines 29-35).

8. In referring to claim 10, in addition to the arguments for claim 1 above, Radziewicz shows the client application removing the window from the output device of the local device that has not interacted with the window for a predetermined amount of time via a timeout process which logs the user out and removes a client application window from the users display screen (col. 15 lines 30-35, fig. D).

9. In reference to claim 11-14, Applicant has amended claims 11, 13 and 15 so that they depend off of claim 10; henceforth the rejection has been modified to reflect this new dependency. Claims 11-14 are now rejected under § 102. In regards to claim 16 see argument for claim 1 above.

10. In referring to claim 20, Radziewicz shows logout procedure or abort procedure which effectively closes communication path with the online service (col. 16 lines 20-22).

11. In referring to claim 6, 7, 27, and 28, Applicant contends that the combination pointed out by Radziewicz and Tazoe does not show all the claimed features, particularly: "if the user has not clicked on an advertisement in the client window within the predetermined amount of time." Applicant points out that Tazoe's reference to inactivity is the mouse being moved outside the application window for a predetermined time. Tazoe measures inactivity as the lack of movement or placement of mouse on a determined window. In other words, Tazoe shows interaction with a window as the movement or placement of mouse in that window. Examiner agrees with Applicant's characterization of Tazoe, yet disagrees with the conclusions reached about the reference and combination. It would have been obvious to one of ordinary skill in the art to recognize that no act of "clicking" a mouse button inside a determined window could also be characterized as inactivity. In addition, Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8, 10-14, 17-26, and 29 are rejected under 35 U.S.C. 102(a, e) as being anticipated by Radziewicz (US 5,854,897).

In referring to claim 1 and claim 22, which claim very similar limitations, Radziewicz shows a system for computer (14) and Network Service Provider (16) establishing communication via a connection path (20) and implementing a modified network server software (24) and a modified browser client software (26). In referring to claim 1 Radziewicz shows a method for displaying advertisements to user of an online service (12) using a client application (24, 26) on a local device (14). Radziewicz also shows:

- A client application activating (the client application comprising of both the modified network server software 24, and modified browser client software 26 shown in fig. 8A) (col. 5 lines 35-38).
- The client application (24, 26) establishing a communication channel (20) from the local device (14) to the online server (12) (col. 5 lines 31-34).
- A browser application activating (fig. 8A: 64, col. 13 line 26).

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- The client application (24, 26) causing at least one advertisement to be displayed on the output device of the local device (see fig. 8A: 66, col. 13 line 28-29).
- The client application (24) monitoring the user's (DTE) interaction with the local device (14) with respect to the client application (26 at 14) and thereby detecting whether the user is interacting with the online service (12) (col. 6 lines 13-18).
- If the user has not interacted with the local device (14) with respect to the client application (20, 24) for a predetermined time, the client application (26) causing a dialog (fig. 8A-8D, 66, 76, 82, 84) to be displayed on the output device of the local device (14), wherein the dialog notifies the user that the user has been idle with respect to the online server (12, 20) by displaying resource locator in the dialog (col. 5 lines 43- col. 6 line 6, col. 12 lines 23-45).

In referring to claim 2 and 23 Radziewicz shows a method wherein the resource locator is associated with an advertisement (col. 12 lines 23-45).

In referring to claim 3 and 24, Radziewicz shows the display of at least one advertisement (announcement) operates in accordance with a first play list (sequence of messages col. 9 line 38-39), the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for click-through associated with the given advertisement (col. 12 line 26-45), at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements are to be displayed (col. 9 line 1-33).

In referring to claim 4 and 25, Radziewicz shows client application pausing the play list if the user has not interacted with the local device with respect to the client application (24) for an amount of time (col. 16 lines 18-23, fig. 3D, col. 15 lines 30-35). Radziewicz shows a storage

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area for recoding a log of the advertisements messages that were already transmitted to the users for futures use in selecting advertisement to display when connection is re-established.

In referring to claim 5 and 26, Radziewicz shows a system for client application displaying at least one advertisement in a client window displayed by the client application (fig. 8A-8D, 66, 76, 82, 84).

In referring to claim 8 and 29, Radziewicz shows client application establishes the communication channel (20) by creating a physical link between the local device and the online server via a PSTN (col. 2 line 59).

In referring to claim 10, having some similar limitation as claim 1, Radziewicz shows:

- A client application activating (the client application comprising of both the modified network server software 24, and modified browser client software 26 shown in fig. 8A) (col. 5 lines 35-38).
- A browser application activating (fig. 8A: 64, col. 13 line 26).
- The browser application displaying a browser window on the output device of the local device (fig. 8A: 64).
- The client application (24, 26) causing at least one advertisement to be displayed in a window on the output device of the local device (col. 5 lines 43-56).
- The client application (24) monitoring the interaction with the window (timed advertisement) and thereby detecting whether the user is interacting with the online server (col. 16 lines 10-26).

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- The client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time (executing a logout procedure, col. 15 lines 30-35, fig. 3D).

In referring to claim 11, Radziewicz shows a window is a client window displayed by the client application (26, fig. 8A).

In referring to claim 12, Radziewicz shows method for removing client window from display (log out), the client application (26) re-displaying the client window (66) on the output device if the user interacts with the browser application (col. 13 line 45-46).

In referring to claim 13, Radziewicz shows the display of at least one advertisement (announcement) operates in accordance with a first play list (sequence of messages col. 9 line 38-39), the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for click-through associated with the given advertisement (col. 12 line 26-45), at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements are to be displayed (col. 9 line 1-33).

In referring to claim 14, Radziewicz shows client application pausing the play list if the user has not interacted with the local device with respect to the client application (24) for an amount of time (col. 16 lines 18-23, fig. 3D, col. 15 lines 30-35). Radziewicz shows a storage area for recoding a log of the advertisements messages that were already transmitted to the users for futures use in selecting advertisement to display when connection is re-established.

In referring to claim 17, the limitations of claim 1, 3, and 4 have been combined. As shown above, Radziewicz teaches:

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- A client application activating (the client application comprising of both the modified network server software 24, and modified browser client software 26 shown in fig. 8A) (col. 5 lines 35-38).
- The client application (24, 26) establishing a communication channel (20) from the local device (14) to the online server (12) (col. 5 lines 31-34).
- A browser application activating (fig. 8A: 64, col. 13 line 26).
- the display of at least one advertisement (announcement) operates in accordance with a first play list (sequence of messages col. 9 line 38-39), the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for click-through associated with the given advertisement (col. 12 line 26-45), at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements are to be displayed (col. 9 line 1-33).
- client application pausing the play list if the user has not interacted with the local device with respect to the client application (24) for an amount of time (col. 16 lines 18-23, fig. 3D, col. 15 lines 30-35). Radziewicz shows a storage area for recoding a log of the advertisements messages that were already transmitted to the users for futures use in selecting advertisement to display when connection is re-established.

In referring to claim 18, Radziewicz shows displaying a dialog (window) if the user has not interacted with the local device with respect to the client application (20, 26, 24) for a amount of time, wherein the dialog notifies the user that the user has been idle with respect to the online server (12, 20) by displaying resource locator in the dialog (col. 5 lines 43- col. 6 line 6, col. 12 lines 23-45).

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In referring to claim 19, Radziewicz shows a window is a client window displayed by the client application (26, fig. 8A).

In referring to claim 20, Radziewicz shows the client application closing the communication channel if the user has not interacted with the locale device with respect to the client application (24) for an amount of time (col. 16 lines 9-26).

In referring to claim 21, Radziewicz shows client application establishing a communication channel from the local device to the online server via telephone connection (col. 4 line 59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radziewicz in view of Tazoe et al (US 6,326,985).

In referring to claim 6, 7, 26, and 27 although Radziewicz shows substantial features of the claimed invention, Radziewicz does not show determining inactivity with respect to the last time user "clicked" in a window. Nonetheless this feature is well known in the art, and would

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have been an obvious modification to the system disclosed by Radziewicz as evidenced by Tazoe.

In an analogous art, Tazoe shows a system for determining inactivity of a client application by detecting dispatch message indicating mouse input in a client application window or on an icon located in a predetermined area of the screen (col. 13 line 62- col. 14 line 15 and col. 15 lines 4-56).

Given this feature, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system shown by Radziewicz to employ the features shown by Tazoe in order to more accurately detect inactivity of a user.

Claims 9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radziewicz in view of knowledge known to one of ordinary skill in the art.

In referring to claim 9, Radziewicz shows client application establishes communication channel (20, 18) via a modem connection (col. 5 line 2). Although Radziewicz does not explicitly show a cable modem, one of ordinary skill in the art would have readily realized this design modification in order to accommodate various communication settings and therefore Official Notice it taken.

In referring to claim 15, Radziewicz shows the displaying of client window (84) on top of the browser window on the output device (fig. 8D). Although Radziewicz does not explicitly shows the window preventing any other window from being displayed on top of the client window (84), this is a well known display design feature known to those of ordinary skill in the

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art. Official Notice is taken on the preventing of any other window from being displayed on top of the client window.

In referring to claim 16, Radziewicz shows the displaying of a window (84) on top of another window on the output device after an idle time (fig. 8D, col. 24 lines 46-66).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

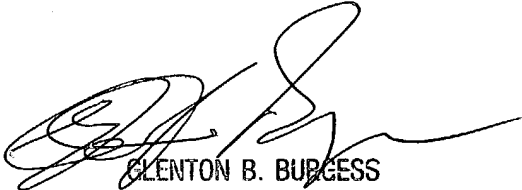
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC
June 21, 2004



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